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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/868,145	06/15/2001	Takehiko Taguchi	788 085	7043
25191	7590	05/13/2004	EXAMINER	
BURR & BROWN PO BOX 7068 SYRACUSE, NY 13261-7068			NUTTER, NATHAN M	
			ART UNIT	PAPER NUMBER
			1711	

DATE MAILED: 05/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/868,145

Applicant(s)

TAGUCHI ET AL.

Examiner

Nathan M. Nutter

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 2 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 11-21,23,24,26 and 27 is/are pending in the application.
- 4a) Of the above claim(s) 11-15,20,21,23,24,26 and 27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 16-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 11-01.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election with traverse of Group V, claims 16-19, in the Paper filed 2 April 2004 is acknowledged. The traversal is on the ground(s) that "the subject matter of claims 11-21, 23, 24, 26 and 27 is sufficiently related that a thorough and complete search for the subject matter of the elected claims would necessarily encompass a thorough and complete search for the subject matter of the non-elected claims... that search and examination of the entire application could be made without serious burden."

This is not found persuasive because each separate Group requires specific attention to the constituents employed. While there is some overlap of searches, these vary greatly and the searches are not co-extensive. The following is a listing of the classes and subclasses for each invention:

Group I Class 525, subclasses 191, 199, 221, 222, 232, 240 and 241,

Group II Class 525, subclasses 191, 199, 214, 218, 221, 222, 232, 240 and 241,

Group III Class 525, subclasses 214, 218 and 232,

Group IV Class 525, subclasses 221, 222 and 232,

Group V Class 525, subclasses 191, 199, 214, 218, 221, 222, 232, 240 and 241,

Group VI Class 525, subclasses 191 and 232.

Surely, to examine all claims with their myriad concepts would pose an undue burden upon the Examiner.

The requirement is still deemed proper and is therefore made FINAL.

***Claim Rejections - 35 USC § 102/103***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 16-19 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Tanahashi et al, cited by applicants.

The reference to Tanahashi et al teaches the production of formed composites produced in an identical fashion as recited herein. The process comprises the mixing of "a rubber component (A), a rubber component (B) vulcanized by a mechanism different from that in the rubber component (A).....wherein the vulcanizate of the rubber component (A) is vulcanized with a vulcanizing agent which can not vulcanize the

rubber component (B) under the vulcanizing conditions of the rubber component (A), and wherein the vulcanizate of the rubber component (A) is dispersed in the rubber component (B)..." as recited in claim 1 of the patent. The rubber component (B), as recited herein, is the rubber component (A) of the patent reference. Note claims 11-13 and 21-23 of the patent which teach the essential steps, as herein claimed, those being:

- 1) mixing together an unvulcanized rubber material A..., an unvulcanized rubber material B..., and a vulcanizing agent capable of vulcanizing only said unvulcanized rubber material B;

- 2) heating a mixture of said unvulcanized rubber materials A and B and said vulcanizing agent, to vulcanize said unvulcanized rubber material B such that fine particles of the vulcanized rubber material B are dispersed in said unvulcanized rubber material A;

- 3) adding to said mixture a vulcanizing agent capable of vulcanizing said unvulcanized rubber material A;

- 4) and forming a thus obtained mixture into a desired shape, and heating the formed mixture to vulcanize said unvulcanized rubber material A, for obtaining said vibration damping rubber member having an island-sea structure in which fine particles of the vulcanized rubber material B are dispersed as a dispersed phase in a matrix phase of the vulcanized rubber material A.

See Example 1 at column 14 (lines 19-34) for steps 1), 2) (lines 35-47) for steps 3) and 4).

The process steps are all shown by the teachings of the reference. As such, the claims are deemed to be anticipated by the reference. The particular choices of rubber constituents that are characterized to "exhibit a low degree of dynamic spring stiffness", and one that "enables the vibration damping rubber member to have a high vibration damping effect" would have been within the purview of a practitioner having an ordinary skill in the art. The reference teaches the employment of components identically disclosed to those contemplated herein at column 6 (line 47) to column 7 (line 41). As such, the instant claims would be deemed at least obvious, if not anticipated, by the teachings of the reference to Tanahashi et al.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 16-19 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 8-14 of U.S. Patent No. 6,465,607, newly cited. Although the conflicting claims are not identical, they are not

patentably distinct from each other because the steps are essentially identical with the exception of the addition of the vulcanization agents. The steps for addition of constituents are not deemed to be patentably distinct since the constituents are all present, as well as the vulcanization steps.

Claims 16-19 are rejected under 35 U.S.C. 103(a) as being obvious over Taguchi et al.

The applied reference has common inventors with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned

by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(I)(1) and § 706.02(I)(2). Although the conflicting claims are not identical, they are not patentably distinct from each other because the steps are essentially identical with the exception of the addition of the vulcanization agents. The steps for addition of constituents are not deemed to be patentably distinct since the constituents are all present, as well as the vulcanization steps.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan M. Nutter whose telephone number is 571-272-1076. The examiner can normally be reached on Monday-Friday 9:30 am to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Nathan M. Nutter". The signature is fluid and cursive, with the first name "Nathan" being more prominent than the last name "Nutter".

Nathan M. Nutter  
Primary Examiner  
Art Unit 1711

nmn

7 May 2004